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Remarks

This is responsive to the Office Action mailed 10/30/2006. The remarks are proper, do not contain new matter, and are not narrowing in any way in view of a rejection over a cited reference.

Rejection Under 35 U.S.C. 103(a)

Claims 1-5, 8, 16-21, and 23-32 stand rejected as being unpatentable over Chung '963 in view of Downs '618. This rejection is respectfully traversed.

Claim 1

Applicant agrees to the extent that Chung '963 does not teach *encoding the portable digital storage module with access instructions corresponding to the entertainment media; retrieving the entertainment media from the memory...in accordance with a permission granted by the access instructions* as claimed. However, Applicant traverses the rejection because Downs '618 does not teach or suggest this feature either.

The Examiner relies on Downs '618 at col. 11 lines 30-55, which clearly delineates the access control activities of the end user device 109, which include: (1) requesting and managing receipt of the encrypted Digital Content keys from the Clearinghouse(s), and (2) processing the watermarks.

The first access control is with respect to the secure container (SC) only. Importantly, it is not *encoding...access instructions corresponding to the entertainment media (Digital Content)* as claimed. That is, one may be able to unlock the SC without having watermark rights to the Digital Content contained within the SC:

Licensing authorization and control are implemented through the use of a Clearinghouse(s) entity and Secure Container (SC) technology. The Clearinghouse(s) provides licensing authorization by enabling intermediate or End-User(s) to unlock content after verification of a successful completion of a licensing transaction. Secure Containers are used to distribute encrypted content and information among the system components. A SC is a cryptographic carrier of information or content that uses encryption, digital signatures, and digital certificates to provide protection against unauthorized interception or modification of electronic information and content.
(Downs '618 col. 7 lines 11-22, emphasis added)

The second access control involves watermarking the Digital Content. Importantly, it involves encoding of the Digital Content itself, not *encoding the portable digital storage module* as claimed:

The control of Content usage is enabled through the End-User Player Application 195 running on an End-User Device(s). The application embeds a digital code in every copy of the Content that defines the allowable number of secondary copies and play backs. Digital watermarking technology is used to generate the digital code, to keep it hidden from other End-User Player Application 195, and to make it resistant to alteration attempts. When the Digital Content is accessed in a compliant End-User Device(s), the End-User Player Application 195 reads the watermark to check the use restrictions and updates the watermark as required. If the requested use of the content does not comply with the usage conditions, e.g., the number of copies has been exhausted, the End-User Device(s) will not perform the request.
(Downs '618 col. 7 lines 11-22, emphasis added)

Thus, none of the access controls in Downs '618, neither the SC encryption nor the watermarking, teaches or suggests *encoding the portable digital storage module with access instructions corresponding to the entertainment media; retrieving the entertainment media from the memory...in accordance with a permission granted by the access instructions as*

claimed. Accordingly, the Examiner has failed to substantiate a *prima facie* case of obviousness because the cited references do not teach or suggest all the features of claim 1. Reconsideration and withdrawal of the rejection of claim 1 and the claims depending therefrom are respectfully requested.

Claim 16

For the same reasons set forth above for claim 1, Downs '618 does not teach or suggest *a purchase system configured to...operably store a user-selected entertainment media to the portable digital storage module, and to store access instructions associated with the user-selected entertainment media to the portable digital storage module in order to prevent unauthorized access....* Accordingly, the Examiner has failed to substantiate a *prima facie* case of obviousness because the cited references do not teach or suggest all the features of claim 16. Reconsideration and withdrawal of the rejection of claim 16 and the claims depending therefrom are respectfully requested.

Rejection Under 35 U.S.C. 103(a)

Claims 9, 10, and 15 stand rejected as being unpatentable over Chung '963 in view of Yamagata '793 and further in view of Downs '618. This rejection is respectfully traversed.

Claim 9

First, for the same reasons set forth for claim 1 above, the cited references do not, neither alone nor together, teach or suggest *a memory in the enclosure...executing instructions stored in the memory for granting the digital format player device access to data*

stored in the memory as claimed. Again, the watermark rights of Downs '618 are encoded instructions in the digital content, not the enclosure (SC); the encryption of the SC is not associated with granting rights to the digital content.

Furthermore, Applicant agrees that neither Chung '963 nor Downs '618 teaches the claimed *controller*. However, Applicant traverses the rejection because Yamagata '793 is improper nonanalogous art. Both Chung '963 and Downs '618 disclose portable devices with processor capability. Yamagata '793, on the other hand, discloses an unintelligent nonportable peripheral component. The device 100 of Yamagata '793 is not suited for use as a portable device for storing media clips. Not only is there absolutely no overlap in the PTO classifications for these references, hence the lie in different fields, but because the device 100 of Yamagata '793 is not suited for use as a portable processing device it is not even reasonably pertinent to the particular problems with which the inventor of the claimed embodiments was concerned.

The Examiner has failed to substantiate a *prima facie* case of obviousness because the cited references do not, neither alone nor together, teach or suggest all the features of claim 9, and because the combination with Yamagata '763 entails a combination with improper nonanalogous art. Reconsideration and withdrawal of the rejection of claim 9 and the claims depending therefrom are respectfully requested.

Rejection Under 35 U.S.C. 102(e)

Claim 33 stands rejected as being anticipated by Downs '618. This rejection is respectfully traversed.

Claim 33 is written in accordance with 35 U.S.C. §112, sixth paragraph. The Examiner is obliged as a matter of law to construe the *means for protecting* element as the disclosed structure, and equivalents thereof, that are capable of the identical function.

The Examiner cites the same passage of Downs '618 (col. 11 lines 30-55) as the basis that it anticipates the *means for protecting*. As set forth in the discussion of claim 1, the disclosed structure entails encoding instructions in the portable device for preventing unauthorized access. Downs '618 discloses watermarking the digital content for the same purpose. The Examiner has failed to substantiate a *prima facie* case of anticipation by not showing evidence that the structure of Downs '618 is equivalent to the disclosed structure. Reconsideration and withdrawal of the rejection of claim 20 are respectfully requested.

Conclusion

This is a complete response to the Office Action mailed October 30, 2006. Applicant requests withdrawal of all rejections and passage of all the pending claims to allowance.

Also submitted herewith is a request for telephone interview. Applicant regrets that the Examiner did not grant the previously requested interview, because now this requested interview is necessary to resolve the issues flowing from the unsubstantiated rejection of all independent claims. The Examiner is invited to contact the Attorneys listed below should any questions arise concerning this response or request for interview.

Respectfully submitted,
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